

In re: Appln No. 09/358,280

Atty Docket: MISTY-52064
6030-021**REMARKS****PRELIMINARY REMARKS**

The Applicant has amended claims 5, 9 and 18 in efforts to clarify the claims. In particular, the phrase “said container having an inlet for filling said container” was added to claim 5 to provide the necessary antecedent basis. The word “type” was removed from claim 9 as suggested by the Patent Office. These amendments remove the basis for the rejection of claim 8 and 9 under §112, second paragraph, and therefore, this rejection is no longer applicable.

In addition to these amendments, the phrase “by introducing a gas to the container” and “capable of pressurizing the container by introducing a gas into the container” was added to claims 5 and 18, respectively. These added phrase help further clarify the pressurization of the container by the manual piston pump of the present invention. This is supported by the specification in general. In particular, the first paragraph of the Summary of the Invention describes a “manual air-pump to pressurized the fluid within the container.”

In response to the reasoning by Patent Office for not giving the functional language “said spray nozzle delivering an evaporative cooling mist of water in the vicinity of a person” any patentable weight, the Applicant has added the phrase “capable of” after “nozzle” and before “delivering” to make sure the functional language is not narrative in form.

All the amendments made herein are for clarification purposes and are fully supported by the specification, in general, and do not introduce new matter.

PRIORITY CLAIM

The Applicant understands that since the Patent Office has failed to include claims 5 and 8 among the list of claims that have not been granted the benefit of the earlier filing date (claims 7, 9, 10, 18-21 and 23), claims 5 and 8 have been granted such benefit. Furthermore, the Applicant is unaware of the basis for the determination that the related, earlier filed applications fails to sufficiently disclosed the claimed invention under 35 U.S.C. §112, first paragraph. In spite of this, the Applicant believes this statement to be incorrect. The following demonstrates that the earlier filed applications do indeed support the current claimed invention and the should be granted the earliest filing date, July 6, 1989.

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In an attempt to anticipate the basis for the denial of benefit of the earlier filing date for claim 7, 9, 10, 18-21 and 23, the Applicants point out particular passages in the earliest filed application, U.S. Serial No. 07/376,380 (the "Priority Application"), which support the present claimed invention. The Applicant refers to U.S. Pat. No. 5,535,951, which is a continuation of Ser. No. 698,356, which is a continuation of Ser. 376,380, when providing citations to the Priority Application. In multiple sections of the Priority Application, the Applicant describes the apparatus as a misting apparatus. In particular, the Priority Application describes the inventive misting apparatus as one that is "adapted to deliver a spray of fluid and evaporatively cool a localized area." See Col. 4, ln. 29-30 (Emphasis added). Additionally, Claim 1 includes the following preamble, "A method for emitting an atomized spray of a fluid to a localized area for evaporatively cooling the localized area around a person." (Emphasis added). The inventive apparatus, and more specifically, the sprayer, is patentable over the prior art at the time because of this new and unobvious sprayer that can emit a mist, or a fine mist or atomized spray, that evaporatively cools a localized area. Henceforth, this fully supports the claimed invention according to pending claims 7, 9, 10, 18-21 and 23 and, therefore, benefit of the earlier filing date should be granted.

Upon granting the requested earlier filing date, the Applicant, again, hereby submits that the present invention was conceived prior to the effective date of Cushing, July 13, 1988, and that Applicant was diligent in his reduction to practice of the same invention; therefore, Cushing should not be considered prior art against the present invention.

THE REJECTION OF CLAIMS 8 AND 9 UNDER §112, SECOND PARAGRAPH IS NO LONGER APPLICABLE

The entry of the amendments made herein eliminates the basis for this rejection and, therefore, this rejection should be withdrawn.

THE REJECTION OF CLAIMS 5, 8, 9, 18, 19, 21 AND 23 UNDER §102(b) OVER NORMAN (842,689) SHOULD BE WITHDRAWN

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The rejection of claims 5, 8, 9, 18, 19, 21 and 23 under §102(b) over Norman (US Pat. No. 842,689) should be withdrawn because Norman fails to disclose all elements of the claimed invention. Norman is limited to a combined water sprayer and fire extinguisher for the distribution of water, and is totally lacking in any discussion of a mist sprayer or a sprayer that delivers an evaporative mist.

In response to the disapproval of the functional recitation by the Patent Office, the Applicants points to MPEP §2173.05(g), which states that "A functional limitation **must** be evaluated and considered, just like any other limitation of the claim. . . ." (Emphasis added). For clarity reasons, the Applicant has amended claim 5 to state a "spray nozzle capable of delivering an evaporative mist" to eliminate any concerns of being "narrative in form."

Norman fails to anticipate the claimed invention because Norman fails to disclose one of the elements of the presently claimed invention, an apparatus that delivers an evaporative mist or a continuous evaporative. The spray nozzle 8, which is referred to by the Patent Office, is only described as one for spraying water or for throwing a solid stream of water. See ln. 89-92. This is not a spray nozzle for emitting an evaporative mist.

Moreover, those skilled in the art would readily recognize that a fire extinguisher must, inherently, rapidly deliver large volumes of fluid to function as an extinguisher. The present invention, as claimed, delivers only an evaporative mist, i.e., one which evaporates in the ambient air, and would be incapable of acting as an extinguisher.

Additionally, Norman also fails to anticipate the claimed invention because Norman does not disclose a pump that pressurizes a container by the addition of air. Norman discloses a water sprayer/fire extinguisher apparatus having a pump that pressurizes a tank by sucking liquid into the tank, which compresses air already contained in the tank. See ln. 78-83. This pressurizing means is significantly different from that in the claimed invention, which sucks in air to pressurize the tank, or container, that is already filled with water via the inlet in the tank. See claim 5, ln. 4 and claim 18, ln. 5-6. Accordingly, Norman fails to anticipate the present, claimed invention because Norman fails to disclose all claimed elements of the invention.

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**THE REJECTION OF CLAIMS 5, 18, 19, 21 AND 23 UNDER §102(b) OVER CUSHING
(4,911,339) SHOULD BE WITHDRAWN**

Cushing should not be considered prior art against the present invention because the Applicant claims benefit of an earlier date under Rule 131 based on the chain of parent applications that relates back to US Serial No. 07/376,380, filed July 6, 1989, a pre-Cushing date of conception plus diligence throughout until reduction to practice, and that Cushing is a 102(e) reference. Absent Cushing, the cited references, alone or in combination, fail to anticipate or render obvious the present invention.

Assuming *arguendo* that Cushing is still held to anticipate the present, claimed invention, the rejection over Cushing should still be withdrawn because Cushing fails to disclose all elements of the claimed invention. Cushing is still limited to disclosing a bicycle water pump that provides drinking water to a bicyclist while riding and fails to disclose an apparatus that delivers an evaporative mist spray to evaporatively cool an area around the user.

In particular, Cushing fails to disclose the claimed element "said spray nozzle capable of delivering an **evaporative cooling mist**" or "means for delivering fluid as a **continuous evaporative mist**" (emphasis added). Cushing discloses a bicycle water pump for delivering water to a cyclist for **drinking** without mounting off of the bicycle and **not for evaporatively cooling** the cyclist. The Patent Office points to structure 20, which is a nozzle for delivering "a stream of liquid from the container, toward the rider's mouth." Col. 2, ln 15-16 of Cushing. The Patent Office appears to have impermissibly ignored the limitation "delivering fluid as a continuous evaporative mist" because Cushing fails to disclose such means of delivering either explicitly or inherently. Any argument that the nozzle in Cushing inherently possesses the ability to produce a continuous evaporative mist is completely erroneous because that would be contrary to the purpose of the invention in Cushing – to deliver fluid for drinking.

Accordingly, Cushing fails to disclose all the limitations of the present, claimed invention and, therefore, the anticipation rejection based on Cushing should be withdrawn.

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**THE REJECTION OF CLAIMS 7, 9, 10 AND 20 UNDER §103(a) OVER CUSHING
(4,911,339) ALONE OR IN VIEW OF A SECONDARY REFERENCE SHOULD BE
WITHDRAWN**

Again, based on a grant of the requested priority benefit claim, Cushing should not be considered prior art against the present, claimed invention and, therefore, without the primary reference, the rejection under §103(a) is no longer applicable.

However, assuming *arguendo*, that the priority benefit claim is not granted, this rejection under §103(a) should still be withdrawn because Cushing, either alone or in combination, fails to teach all elements of the claimed invention. As mentioned in the arguments rebutting the 102 rejections over Cushing, Cushing fails to disclose an apparatus or a spray nozzle that delivers an evaporative cooling mist, which is an important element of the present, claimed invention. Furthermore, nothing in Cushing or the secondary references, Shurnick et al. (US Pat. No. 4,852,781) or Norman, suggest such a device or such a nozzle for delivering an evaporative cooling mist.

In addition, the rejection of claims 18, 19 and 21 over Cushing in view of Norman should be withdrawn also because the piston pump of Norman does not teach the pump of the present invention. Norman discloses a pump that draws water into a tank, thereby creating the pressure to expel some of the water out through a discharge-pipe 3. See ln. 78-83. This is not the manual pump of the present invention, and furthermore, there is no suggestion in Norman or Cushing to incorporate a piston pump that can pressurize a container that holds water by adding air.

Accordingly, either the rejection under §103(a) is moot because Cushing is no longer prior art or the rejection should be withdrawn because all elements of the present, claimed invention are not taught by Cushing alone or Cushing in combination with Norman or Shurnick.

CONCLUSION

Based on the arguments and amendments, above, the Applicant submits that all pending claims, claims 5, 7-10, 18-21, and 23 are in condition for allowance. The Applicant respectfully requests that all pending claims be allowed.

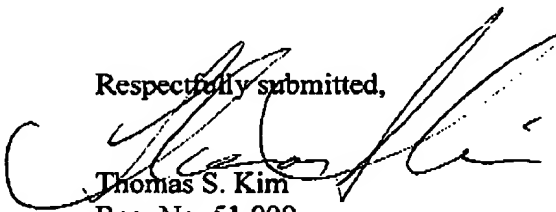
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This response is filed timely. Should any additional fee be deemed necessary, however, the Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment, to Rosenbaum & Associates, P.C. deposit account No. 18-2000.

Should the Examiner require any further information or wish to discuss any aspect of this Response, the Examiner is encouraged to telephone the undersigned at the telephone number set forth below.

Respectfully submitted,


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April 9, 2004
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